

## REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the specification

The specification is amended to include suitable section headings and to remove reference to the claims. Entry of the amendment to the specification is respectfully requested in the next Office communication.

2. In the drawings

Claim 8 is cancelled without prejudice or disclaimer so as to, at least in part, remove the objection to the drawings. A drawing correction is no longer considered necessary. Removal of the objection to the drawings is respectfully requested in the next Office communication.

3. In the claims

In the Amendment to the Claims, claim 1 is amended to particularly recite that the “content of the” first and second information is different. Support for this amendment is readily apparent from the drawings and the corresponding discussion in the specification (e.g., page 3, 3<sup>rd</sup> full paragraph). As indicated above, claim 8 is cancelled.

Entry of the amendment to the claims is kindly requested in the next Office communication.

4. Rejection of claims 1, 2, 4, 9, 11-15 and 17-22 under 35 U.S.C. § 102(b) as being unpatentable over U.S. patent 5,688,587 (*Burchard*)

Reconsideration of this rejection is requested in view of the amendment to independent claim 1, from which the remaining claims in the rejection depend, and the following remarks.

In observing amended claim 1, the claim is directed to a security element having a cover layer defining gaps in the form of characters or patterns forming visually and/or machine readable first information. The security element further includes a printed image forming visually and/or machine readable second

information particularly disposed in and in register with the gaps (forming the first information). The content of the first information is different from the second information.

Turning to *Burchard*, it is clear that the security element thereof does not have a gap forming first information and a printed image forming second information, and disposed in and in register with the gaps such that the content of the first and second information is different. Instead, *Burchard* discloses a security element in the form of a metallized thread or band, and a print 8 which is described as being located on metal-free intermediate areas 7.

In observing Fig. 7, which is relied upon in the action, the print 8 and the gaps 5 in the metallized thread have the same form so that the print 8 can be disposed within the gaps 5 (5:21-25). This is expressly contrary to the requirement in claim 1. As explained in *Burchard*, the print and the gaps have the same form so they can be disposed one within the other such that the gaps 5 in the metal layer 4 simultaneously constitute intermediate areas 7 in which the print 8 is applied (5:25-30).

From Fig. 7 and the discussion thereof, it is submitted that the skilled person would not understand providing gaps constituting first information and a print provided therein and forming second information which has content different from the first information. Instead, the skilled person would learn from *Burchard* the notion of providing gaps which have the same information as the print as is readily apparent from the P-shaped gap having a printed "P" provided therein along with the L-shaped gap having a printed "L" provided therein. The skilled person would understand that the print must necessarily have the same shape as the gap, thereby resulting in the same information.

The applicant respectfully disagrees with the rejection's stated rationale as to how the skilled person would arrive at the security element of claim 1 from the teachings of *Burchard*. It is submitted that the skilled person would not understand to superpose two pieces of information each having a different information content and generate the claimed security element since claim 1 particularly requires that the second information is disposed exclusively and in register within the first information.

There is simply no understanding in *Burchard* that the proposed flag design (second information) referenced in the rejection would necessarily fit within a gap, even upon a size reduction. Only perhaps upon a substantial reduction of the second information could it be able to fit with one of the described gaps in *Burchard* without overlap. However, the rejection provides no stated rationale or evidence in *Burchard* which would direct the skilled person to reduce information of one feature so it can fit within one of the described gaps in the security element. Instead, as discussed above, *Burchard* directs the skilled person to provide the same printed information in a same shaped gap so it can fit with one another.

As such, it is submitted that the skilled person would not understand to make a security element of the type recited in claim 1 from *Burchard*. Therefore, claim 1 is not *prima facie* obvious in view of *Burchard*.

From these observations, it is submitted that *Burchard* does not teach every limitation required by independent claim 1, and the claims dependent therefrom. Accordingly, withdrawal of this rejection is respectfully requested.

5. Rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 5,573,639 (*Schmitz*)

Rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 5,516,153 (*Kaule I*)

Rejection of claims 6-8 and 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent application publication 2005/0151368 (*Heim*)

Rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,344,261 (*Kaule II*)

Rejection of claims 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 5,759,420 (*Minnetian*)

Reconsideration of these rejections is requested in view of the amendment to claim 1 and the discussion provided above. The claims of the above-identified rejections are related or dependent from claim 1. It is submitted that none of *Schmitz*,

*Kaule I, Heim, Kaule II and Minnetian*, make up for the aforementioned shortcomings of *Burchard*.

Accordingly, it submitted that the proposed combinations of *Schmitz, Kaule I, Heim, Kaule II and Minnetian* with *Burchard* fail to render the rejected claims *prima facie* obvious. Withdrawal of these rejections is respectfully requested.

6. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicant's attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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